REMARKS

Reconsideration of the Final Office Action mailed April 7, 2003, (hereinafter "instant Office Action") and withdrawal of the rejection of claim 58, are respectfully requested.

In the instant Office Action, claims 1-60 are listed as pending, claims 1-57 are listed as withdrawn from consideration, claims 59 and 60 are listed as allowed and claim 58 is listed as rejected.

The Examiner has rejected claim 58 under 35 U.S.C. § 103(a) over U.S. 3,810,988 (hereinafter "Janiak"). The Examiner alleges that "the reference generically teaches the instant compounds and prepares numerous adjacent alkyl homologues as in ex. 3, 22, 25, 35, 36. Further exs. 10, 11, 13 and 14 generically teach positional isomers of the instant claims and would be obvious to one skilled in the art as biocides". Applicants respectfully traverse this rejection.

As stated in M.P.E.P. §2144.09, "Homology should not be automatically equated with *prima facie* obviousness because the claimed invention and the prior art must each be viewed "as a whole". In re Langer, 465 F.2d 896, 175 USPQ 169 (CCPA 1972). In viewing the prior art and the claimed invention each "as a whole", one must determine the differences between the prior art and the claims. As stated in the Reply filed July 7, 2003, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp.,713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Janiak is directed to compounds used as microbiocidal agents to control phytopathogenic fungi. The instant application is directed to compounds to be used as therapeutic agents. Applicants' compounds have a completely different use than the compounds in Janiak, i.e. kinase inhibitors as opposed to biocides. Further, one of ordinary skill in the art would not be motivated to look to Janiak for a suggestion of Applicants' Claim 58, since the two subject matters are in such divergent fields.

A proper obviousness rejection under 35 U.S.C. § 103 must be based upon a finding that the invention was (1) obvious to try; and (2) there was a reasonable expectation of success. *In re O'Farrell*, 7 USPQ2d 1673 (CAFC 1988). One of ordinary skill in the art would not look to Janiak's compounds which are disclosed to control phytopathogenic fungi for use as kinase

inhibitors because the two fields are unrelated and there would be no expectation that such compounds would inhibit kinase activity. In his rejection, the Examiner states that the claimed compounds would be obvious to one skilled in the art as *biocides* (emphasis added). However, Applicants' compounds are kinase inhibitors, not biocides.

Applicants direct Examiner's attention to M.P.E.P. 2143.01 which states:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The reference contains no motivation or teaching to modify Janiak to arrive at Applicants' genus. The Examiner has not shown how Janiak renders obvious the entire genus of Applications' claim. Applicants maintain that Janiak does not render claim 58 obvious.

Based upon the foregoing, Applicants believe that claims 58-60 are in condition for allowance. Prompt and favorable action is earnestly solicited.

If the Examiner believes that a telephone conference would advance the condition of the instant application for allowance, Applicants invite the Examiner to call Applicants' agent at the number noted below.

Respectfully submitted,

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